

Applicant contends that electronic data is changed using the operation method as seen in claims 1-14 and 24-26, and thus satisfies a transformation as defined by the present “Machine-or-Transformation” test as set forth under the Federal Circuit Court’s decision handed down in the case of *In re Bilski*, 545 F.3d 943, 88 U.S.P.Q.2d 1385 (Fed. Cir. 2008).

Furthermore, in the “Response to Applicant’s Arguments” section of the Office Action, the Examiner has failed to set forth any clear reasoning why electronic data being changed in the claimed method does not satisfy a transformation as set forth in the case of *In re Bilski*.

Accordingly, the subject matter of claims 1-14 and 24-26 is believed to be directed to statutory subject matter under 35 U.S.C. § 101, and thus it is requested that the rejection be withdrawn.

### ***Claim Rejections - 35 U.S.C. § 103***

Claims 1, 6, 8, 14, 16, 19, 21 and 23-26 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Heinrich (U.S. Pub. No. 2003/0046128 A1) (*Heinrich*, hereinafter) in view of Tschiegg et al. (U.S. Pub. No. 2003/0160818 A1) (*Tschiegg*, hereinafter). Claims 2-5, 7, 9-13, 15, 20 and 22 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Heinrich* in view of *Tschiegg* and in further view of Lovejoy et al. (U.S. Pub. No. 2002/01238416 A1) (*Lovejoy*, hereinafter). Applicant traverses the rejections for at least the reasons set forth below.

Applicant contends that present independent claims 1 and 16, and the claims dependent therefrom, are patently distinguishable over *Heinrich*, *Tschiegg* and *Lovejoy*, since *Heinrich*, *Tschiegg* and *Lovejoy*, taken either alone or in combination, fail to disclose, teach or suggest all of the features recited in the pending claims. For example, independent claim 1 (emphasis added) recites:

1. A computer-implemented method for assessing risk within an organization, comprising:
  - defining one or more zones, each of said one or more zones comprising an environment;
  - identifying one or more assets of said organization, each of said assets being located in a respective one of said zones;
  - conducting a respective impact assessment for each of said assets, each assessment comprising assessing the impact**

**of the loss of said respective asset;**

conducting for each of said zones a respective zone risk assessment, comprising assessing the risk level associated with placing a respective asset within said respective corresponding zone;

conducting for each asset a respective asset risk assessment, comprising assessing the risk level associated with said respective asset independent of the respective zone of said respective asset; and

assessing risk on the basis of at least said impact assessment, said zone risk assessments and said asset risk assessments.

Independent claim 16 (emphasis added) recites:

16. An apparatus for assessing risk within an organization, comprising:

data input means for inputting asset information into a register of assets, each of said assets being an asset of said organization, each of said assets being located in a respective zone;

data storage for storing said register of assets, including for each of said assets said respective zone;

means for receiving or storing a respective zone risk assessment for each of said zones, said respective zone risk assessment comprising an assessment of the risk level associated with placing a respective asset within said respective corresponding zone;

**means for receiving or storing a respective asset risk assessment for each asset, said respective asset risk assessment comprising an assessment of the risk level associated with said respective asset independent of the respective zone of said respective asset;**

**means for receiving or storing a respective impact assessment for each of said assets, each assessment comprising assessing the impact of the loss of said respective asset, and for assessing risk on the basis of at least said impact assessment, said zone risk assessments and said asset risk assessments to thereby form a risk assessment; and**

output means for outputting said risk assessment.

It is Applicant's contention that neither *Heinrich*, *Tschiegg*, nor *Lovejoy*, taken either singly or in any proper combination, anticipate or render obvious at least the above-identified features recited in present independent claims 1 and 16.

The primary *Heinrich* reference fails to teach or suggest numerous features of the present invention, as acknowledged by the Examiner on page 6 of the Office Action, but who is reliant

upon *Tschiegg* for making up for the shortcomings of *Heinrich*.

As seen on page 6 of the Office Action, the Examiner alleges that *Tschiegg* discloses the feature of “conducting for each of said zones a respective zone risk assessment, comprising (paragraph 0058-0069, regarding the filter function that allows for customized reporting about specific risk management segments).” However, upon close review, paragraphs [0059]-[0069] of *Tschiegg* merely states:

[0058] In one embodiment of the invention, users may interactively filter data from their respective risk management information segments 12.sub..oval-hollow. by selecting one or more risk management filters 40 of graphics interface 16. FIG. 1 illustratively shows an array of filters 40(1) . . . 40(K). Filters 40 manipulate data of risk management information 12 for display to users at computers 14; for example one filter 40(1) may be used to generate graphic 34 at computer 14(1). A user of system 10 may save configurations of filters 40 so that, for example, only that user can view and utilize the saved filter; or so that a filter 40 may be seen and utilized by anyone with access to a particular information segment 12.sub..oval-hollow.. Moreover, a user may define a filter 40 and save the filter with his associated risk management information segment 12.sub..oval-hollow. so as to later use the filter in other sessions. Representative filters 40 for use in system 10 may for example exhibit the following non-limiting properties:

[0059] Filters 40 are preferentially available to the most active data fields

[0060] Filters 40 may operate on multiple data fields

[0061] Filters 40 support date ranges and user specified field values

[0062] Filters 40 utilize criteria carried forward to multiple reports

[0063] Filters 40 are accessible at all times

[0064] Filters 40 may be changed at any time

[0065] Filters 40 operate to de-clutter reports with inactive data fields

[0066] Filters may be saved or deleted

[0067] All filters 40 may be applied concurrently or individually

[0068] Filters may be common (shared and viewable by all) or personal (unique to a specific user)

[0069] By way of a first example, FIG. 2 shows one representative data graphic 50 generated by and for a user at computer 14(1) and utilizing data from risk management information segment 12(2) through interaction with graphics interface 16. Graphic 50 shows a fire protection report with a scope of Asia and Australia. A filter 40 may be used to filter data of graphic 50. By way of example, FIG. 3 shows one interactive filter 52 available to computer 14(1) that serves to limit the region to China and also to locate "poor" sprinkler protection ratings. Once selected, the graphic data 34' available to the user may be a report 54, such as illustrated in FIG. 4.

As seen in the above passage, *Tschiegg* discloses filtering data from determined respective risk management information segments *i.e.*, this data is merely based upon the *determined loss before and after implementation of a recommendation* (e.g., see also, *Tschiegg* at paragraphs [0005] and [0019]). In the context of the present invention, the feature of, at least, "conducting a respective impact assessment for each of said assets, each assessment comprising **assessing the impact of the loss of said respective asset** (emphasis added)," which measures impact as a total loss of asset, is fundamentally different from the teachings in *Tschiegg* that simply determine loss before and after an implementation of recommendation. Accordingly, the teachings of *Tschiegg* are simply not broad enough to cover the scope of the invention recited in, at least, independent claims 1 and 16.

Applicant further contends that the present invention computes loss based on the potential worst case consequential impacts. The impact criteria of the present invention are as follows: 1) Loss of Opportunity, 2) Loss of Productivity, 3) Loss due to Regulatory and Contractual Breaches, 3) Cost of System Investment, and 4) Loss due to Confidentiality Breaches. Thus, as clearly seen in the list of impact criteria, there is no consideration of risk analysis against the existing controls in place, as recited in, at least, independent claims 1 and 16.

Moreover, the model proposed by *Tschiegg* is comparative in nature, *i.e.*, measuring risk assessment of impact of existing controls before and after impact. For example, a service

provided by a computer system may lose an organization \$100K if there is a power outage (i.e., the Maximus loss). However, if the computer system has an uninterruptable power supply (UPS) the loss to the organization may be reduced to \$50K (i.e., the *Tschiegg* definition of impact). However, with the further recommendation of a power generator the loss may, e.g., be reduced to \$20K (i.e., the *Tschiegg* definition of impact). However, the presently claimed invention, assesses impact without consideration of existing controls, such as a UPS or a power generator, which is fundamentally different and distinct from the teachings of *Tschiegg*.

Furthermore, Applicant asserts that *Lovejoy* fails to make up for the deficiencies with respect to *Heinrich* and *Tschiegg*. For at least the reasons stated above *Heinrich*, *Tschiegg*, and *Lovejoy*, taken either alone or in combination, fail to anticipate or render obvious each and every feature recited in present independent claims 1 and 16. Thus, the Examiner has failed to provide a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests the withdrawal of the rejection of independent claims 1 and 16 under 35 U.S.C. § 103(a), and the allowance of these claims.

Claims 2-15 and 17-26 are allowable at least by virtue of their dependency from one of the independent claims, but also because they are distinguishable over the prior art.

In view of the foregoing, it is submitted that the present application is in condition for allowance and a notice to that effect is respectfully requested. If, however, the Examiner deems that any issue remains after considering this response, the Examiner is invited to contact the undersigned attorney/agent to expedite the prosecution and engage in a joint effort to work out a mutually satisfactory solution.

In discussing the specification, claims, and drawings in this response, it is to be understood that Applicant in no way intends to limit the scope of the claims to any exemplary embodiments described in the specification and/or shown in the drawings. Rather, Applicant is entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

**EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this

application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 19-2380. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Should the Examiner believe that a telephone conference would expedite issuance of the application, the Examiner is respectfully invited to telephone the undersigned patent agent at (202) 585-8316.

Respectfully submitted,

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